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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,342	12/06/2000	Benjamin Wiegand	JBP-529	9185

7590 03/25/2004  
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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/731,342	WIEGLAND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gina C. Yu	1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Receipt is acknowledged of appeal brief filed December 23, 2003. The finality of the Office action dated May 7, 2003 is hereby withdrawn in view of applicants' arguments and upon further consideration.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether any necessary experimentation is "undue" include, but are not limited to: the breadth of the claims; the nature of the invention; the state of the prior art, the level of one of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples, and the quantity of experimentation needed to make or use the invention based on the content of the disclosure. See In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q. 2d 1400, 1404 (Fed. Cir. 1988).

Claim 17 refers to the composition in claim 1, which is a method of using a composition in the form of ringing gel. Ringing gel is conventionally known as Ringing gel as taught in Dawson is defined as a rigid gel which, by tapping the gel lightly it will

vibrate and return to its original configuration. However, applicants claim in claim 17 that the composition is in the form of "a bath, a mousse, a rinse, a lotion, a cream, a wipe, a brush, a sponge, or a spray". Applicants' original specification fails to enable the claimed method of using the composition in claim 17 because there is no disclosure, direction, or working example as to how make/use the recited "composition" there from the claimed ringing gel in claim 1. For example, one of ordinary skill in the art would not know how to make/use the composition in the form of "wipe, a brush, a sponge, or a spray" from a rigid gel composition. Undue experimentation would be necessary to determine how to make/use the method of claim 17.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the viscosity" in claim 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 is vague and indefinite because the claim recites that "the composition" is in the form of "a wipe, a brush, a sponge". It is not clear what applicants mean by a composition is in the form of a wipe, a brush, or a sponge. Do applicants intend to claim method of using an articles or composition?

***Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 4-8, 11-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dawson et al. (US 4772427) ("Dawson").

Dawson discloses a topical ringing gel composition comprising sodium lauryl ether sulfate (an anionic surfactant), polyoxyethylene-glycol ether of lanolin alcohol (a nonionic surfactant), isopropyl myristate, and perfume. See Example 1. See instant claim 1. The formulation in Example 1 contains isopropyl myristate, meeting the oil phase limitation of instant claims 1, 4-6. The method of depositing benefit ingredients, such as perfume as claimed is inherently practiced by applying the prior art composition. The formulation in Example 1 also discloses using water to make up 90% of the total weight. See instant claims 11-17.

Merck's Index teaches that isopropyl myristate is a liquid of low viscosity. See p. 5069; instant claims 7 and 8.

2. Claims 1 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Herman (Global Cosmetic Industry, vol. 162, n. 2, pp. 22 and 24).

Herman discloses that the basic components of a ringing gel formulation are oil, water, a surfactant, and a cosurfactant. See p. 22, 1<sup>st</sup> col., the paragraph bridging

cols.1 and 2. See col. 2 penultimate paragraphs where the surfactants are mixtures that read on claims 1(a) and 20 (a). The oil phase reads on claims 1(b) and 20(b).

The reference teaches the general applicability the "ringing gel" for personal care compositions. See p. 22, 1<sup>st</sup> col., 1<sup>st</sup> paragraph and p. 22, 1<sup>st</sup> col., 1<sup>st</sup>. Herman further teaches that multiple surfactants may be used to render wide distribution of surface-active properties, with examples of using different moles of ethoxylates. Using nonionic surfactant, polysorbate 20 to mix with fragrance oil, is also disclosed. The topical use of the composition inherently results in depositing fragrance on the skin.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 2, 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson in view of Santora et al. (US 6046145).

While Dawson teaches using 2-4 % of isopropyl myristate, the reference fails to teach using 5-40 % by weight of oil phase. The reference also teaches using up to 23 % alkyl ether sulfate surfactant and up to 24 % of ethoxylated fatty alcohol or fatty ester, an fails to meet the claimed 60-95 % weight limitation for the surfactant phase. See instant claim 9.

Generally, difference in concentration will not support patentability unless criticality of the concentration is shown. In this case, Dawson generally teaches using high amount of surfactants is required. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to have discovered the optimum amount of oil and surfactants by routine experimentation.

Dawson fails to teach amphoteric surfactants.

Santora et al. teach a cleansing and moisturizing surfactant compositions comprising nonionic, amphoteric, and anionic surfactants in the amount of 5-20 % by weight and humectants in 0.01-3 % by weight, see col. 2, lines 14 – 32. Instant claims 10, 13-15 are met by this disclosure. The surfactants of claims 2 and 3 are disclosed in col. 3, line 22 – col. 5, line 12 and in col. 7, line 8 – col. 9, line 29. The surfactant system is said to provide mildness, non-greasiness, and non-irritating effects upon application to skin or hair, and provides good cleansing and moisturizing action. See col. 1, line 13 – col. 2, line 59. The mildness to eyes is especially emphasized. Addition of fragrance, coloring agents, and chelating agents is also disclosed, meeting claim 1. The method of depositing the benefit agents is practiced by topically applying the composition as taught.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Dawson by adding the surfactants as suggested by Santora because of the expectation to have successfully produced a mild and non-greasy skin or hair care compositions with good cleansing effects.

3. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman in view of Damani et al. (US 4514385).

Herman is discussed above. The reference lacks the teaching of anti-acne actives.

Damani teaches that a gel acne treatment is well known in the art. Example 1 shows a gel composition using salicylic acid and benzoyl peroxide.

Victor teaches a gel composition comprising benzoyl peroxide, polyoxyethylene cetyl ether (surfactant) and stearic acid and palmitic acid (fatty acid).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Herman by adding anti-acne actives as motivated by Damani or Victor because of the expectation of successfully producing a anti-acne gel composition. The claimed method of depositing anti-acne actives is an obvious use of the composition.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are moot in view of the new ground(s) of rejection in part and not persuasive in part.

The previous rejection made over Herman in view of Santora and Marin, is now withdrawn. However, examiner views that a new rejection made over Dawson in view of Santora may also raise the same issue applicants addressed in the Brief filed on December 23, 2003. Applicants argued in the Brief that the Office failed to show reasonable basis for an expectation of success. Applicants specifically argue that varying the concentration of water, surfactant, and oil phase may no longer result in ringing gel. In response, examiner notes that the test for obviousness is not whether



the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, both Dawson and Santora are directed to cosmetic cleansing compositions. Santora teaches the motivation to use the mild surfactants taught therein. Examiner views the combined teachings sufficiently provide objective suggestion to one of ordinary skill in the art to use the Santora surfactants in the Dawson composition, absent evidence to the contrary. Furthermore, claims 1 and 20 are not limited to using any specific type or quantity of surfactants. Any surfactants in any amounts of surfactants meet the limitation of claims 1 and 20.

Examiner also notes that applicants' argument that adding a benefit agent to a ringing gel somehow provides enhanced benefit deposition relative to other composition is not supported by any factual evidences in the record.

### **Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

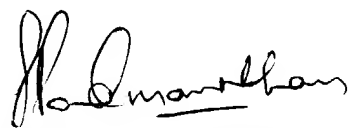
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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Information regarding the status of an application may be obtained from Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should applicants have questions on access to the Private PAIR system, applicants can contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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